IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In The Matter of Application Serial Nos. 76/103,447 and 76/103,448
Published In The Official Gazette of May 22, 2001
and April 24, 2001, Respectively

Mark: HYPERSONIC

----------X

Central Mfg. Co., :

Opposer, : **Opposition No. 123,765**

- against- :

Paramount Parks Inc., :

Applicant. :

----------X

BOX TTAB
NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Applicant's Memorandum in Opposition to
Opposer's Motion To Amend Its Notice of Opposition

Applicant Paramount Parks Inc. ("Paramount") submits this memorandum of law in opposition to Opposer Central Mfg. Co.'s ("Central") motion to amend its notice of opposition.

In support of its motion to amend, Central argues only that Applicant would not be prejudiced by the proposed amendment because discovery is still open, without advancing any rationale for why the amendment is necessary or why there has been a nearly three-year delay in seeking amendment. *International Finance Corporation v. Bravo Co.*, 64 U.S.P.Q.2d 1597,

1604 (TTAB 2002) (motion to amend denied where discovery still open, but movant provided no explanation for two-year delay in seeking to add new claim). Under Rule 15(a) of the Federal Rules of Civil Procedure and 37 CFR § 2.107, leave of the Board is required for any amendment sought more than 20 days after it is served. As noted in the TTAB Manual of Procedure, "[t]he timing of a motion for leave to amend under Fed. R. Civ. P. 15(a) plays a large role in the Board's determination of whether the adverse party would be prejudiced by allowance of the proposed amendment." TTAB Manual of Procedure § 507.02(a) (2003).

In addition to other, less significant changes scattered throughout the notice of opposition, Opposer seeks to delete former paragraphs 20 and 22, and add new paragraphs 23, 24, and 36. The two paragraphs Opposer has deleted state variously that Applicant had been using the mark listed in Application SN: 76,103,447 prior to the filing of that application. Paramount does not object to those deletions except on the grounds of timeliness. Applicant opposes the addition of the new paragraphs on the basis that they are untimely, prejudicial and asserted merely to harass Applicant. The first two paragraphs Opposer seeks to add state as follows:

> 23. At the time the Applicant filed the said Application, it was not the owner of the mark.
>
> 24. Applicant failed to disclose its relationship with Viacom International, Inc. at the time it filed its said trademark Application which was fatal to Applicant's said application.

In its motion for summary judgment, Central argued that because Paramount is a "related company" to Viacom Inc. ("Viacom"), Paramount was not the owner of the mark. Sum. J. Mot., ¶¶ 26-27. In response, Paramount proffered an affidavit of Paramount's Vice President, who affirmed that Paramount is a wholly owned subsidiary of Viacom, but a fully functioning, separate

company that is independently incorporated, and registers and uses trademarks in its own name, and on its own goods. Affidavit of Lester Nail in opposition to Opposer's motion for summary judgment, sworn to April 8, 2003, ¶¶ 3-5. Paramount controls the use of its marks, including the HYPERSONIC marks, and the benefits of that use inure to Paramount, not its ultimate corporate parent. Nail Aff't, ¶ 10. Under Section 1201.01 of the TMEP, "[t]he owner of a mark is the party who controls the nature and quality of the goods sold or services rendered under the mark." Section 1201.03(c) of the TMEP provides that control and ownership under such circumstances is to be presumed, and Opposer presented no evidence on its summary judgment motion to rebut that assumption, other than an unsupported suggestion that, because it received correspondence from counsel for Viacom, and because that counsel prepared some portions of the Applications or Amendments to Allege Use, somehow this nullified the corporate identity of the Applicant.[1]

With respect to the proposed addition of Paragraph 36, that paragraph reads as follows: "During the pendency of this opposition, the Applicant attempted to amend its said application without the permission of Opposer, and without permission of the Board." However, in its Order of March 9, 2004, the Board ruled, in response to Opposer's motion for Rule 11 sanctions on the basis that Applicant filed Amendments to Allege Use during the black-out period, that the filing of Amendments to Allege Use is a part of the *ex parte* examination of the application, and that improper filing of such Amendments is ineffective and results in a return of the Amendments and filing fees to the applicant. Order, p. 12. As such, it cannot possibly serve as a relevant allegation in

1 While certain aspects of Paramount's legal work in connection with trademark registration and compliance is handled by Viacom corporate counsel, in those circumstances, Viacom attorneys are acting as counsel for Paramount. Affidavit of Michelena Hallie in opposition to Opposer's motion for summary judgment, sworn to on April 8, 2003, ¶ 8.

the notice of opposition.

Most importantly, whatever reasons Applicant might advance for these amendments (but has not), no new information has arisen since the filing of the original notice of opposition in September 2001 that would justify an amendment at this later hour. Currently, discovery in this proceeding is scheduled to close on June 11, 2004, and especially with regard to the issue of the corporate relationship between Viacom and Paramount, Applicant opposes the amendment because it might substantially expand the scope of discovery.

CONCLUSION

For the foregoing reasons, Opposer's motion to amend its notice of opposition should be denied.

Dated: New York, New York
April 27, 2004

DAVIS WRIGHT TREMAINE LLP

By: Marcia B Paul

Marcia B. Paul (MBP-8427)
1633 Broadway
New York, New York 10019
(212) 603-6467

Attorneys for Applicant Paramount Parks Inc.

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2900 Crystal Drive
Arlington, Virginia 22202-3513

Applicant's Memorandum in Opposition to
Opposer's Motion for Reconsideration

Applicant Paramount Parks Inc. ("Paramount") submits this memorandum of law in opposition to Opposer Central Mfg. Co.'s ("Central") motion for reconsideration of the Board's Order of March 9, 2004, denying, *inter alia*, Opposer's motion for summary judgment.

Central's motion is without merit. In essence, Central argues that the Board erred in denying Central's motion for summary judgment because Paramount has not met its burden of proof with respect to Central's "non-use" of its trademark, and that therefore the presumption of use that is

accorded to federally registered marks somehow conclusively determines this dispute. Central also states in conclusory fashion, without further explanation as to why the Board's decision was erroneous on point, that the goods of the parties are sufficiently "related" that there is a likelihood of confusion between the marks, and that Paramount's use of its marks does not constitute a use in interstate commerce. Because Central has not raised any new argument with respect to the latter two issues, this memorandum will address only the first point.[1]

In brief, Central's arguments as to its registration and Paramount's counterclaim for abandonment do not go to the merits of the Board's decision. On a motion for summary judgment, the Board must merely determine whether the Opposer has demonstrated the absence of any genuine issues of material fact, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56. All doubts as to whether or not particular factual issues are genuinely in dispute must be resolved against the moving party, and the evidence of record and any inferences which may be drawn from the underlying facts must be viewed in the light most favorable to the nonmoving party. See Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

The Board properly found that there are clearly genuine issues of fact in dispute, and although it noted only a few such issues (the existence of Applicant's counterclaim for abandonment, the absence of documents establishing Opposer's use of its mark in commerce, Opposer's standing), it also stated that "[t]he fact that we have identified only a few genuine issues of material fact . . .

---

1 Central also argues that the requirement of service by Express Mail, imposed by the Order, is improper because Paramount did not rebut the *prima facie* proof of service of those responses, and thus did not meet its burden of proof that service was not timely. Yet the Order is not based on Paramount meeting that burden, but merely states that the allegations "raise serious questions as to the timeliness of service of opposer's discovery responses" (p. 9); the Board then imposed the Express Mail requirement to "avoid further disputes" (p. 10). However, to clarify this matter, a copy of the postmarked envelope enclosing Opposer's discovery responses is submitted herewith, along with an affidavit demonstrating more fully that delivery of the responses was not timely, and that Opposer's actions since the imposition of the Express Mail requirement confirm that the Express Mail requirement is appropriate

should not be construed as a finding that these are necessarily the only issues that remain for trial." Order of Mar. 9, 2004, p. 8 n.9. Central's argument that Paramount has not met its burden of proof on abandonment is clearly premature, as Paramount has not moved for judgment on that counterclaim, and no decision or "assumption" (Opposer's Mem., at 4) has been made by the Board as to the validity of that counterclaim. The Board cited the issue of abandonment simply as a disputed issue of fact, which it clearly is.

Although a federal registration creates a presumption of validity, that presumption is subject to rebuttal. *See Tie Tech, Inc. v. Kinedyne Corp.*, 296 F.3d 778, 783 (9th Cir. 2002) ("In trademark terms, the registration is not absolute but subject to rebuttal"). Here, Paramount has filed a counterclaim for abandonment, and stated in an affidavit supporting its opposition papers that it can find no evidence of use of Opposer's mark in interstate commerce. Given Central's refusal to produce documentary evidence and appear for deposition,[2] Paramount's claim for abandonment and efforts to demonstrate non-use are more than sufficient to establish an issue of fact on point; Central cannot hide behind its failure to produce discovery and simultaneously claim that Paramount has not produced sufficient evidence of abandonment.

Koonce Affidavit, Ex. 1.

2 Since the filing of its motion for reconsideration, Central has finally produced a small number of documents and appeared for deposition.

CONCLUSION

For the foregoing reasons, Opposer's motion for reconsideration should be denied.

Dated: New York, New York
April 27, 2004

DAVIS WRIGHT TREMAINE LLP

By: Marcia B. Paul

Marcia B. Paul (MBP-8427)
1633 Broadway
New York, New York 10019
(212) 603-6467

Attorneys for Applicant Paramount Parks Inc.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In The Matter of Application Serial Nos. 76/103,447 and 76/103448
Published In The Official Gazette of May 22, 2001
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Mark: HYPERSONIC

----------X

Central Mfg. Co.,	:	
Opposer,	:	**Opposition No. 123,765**
- against-	:	
Paramount Parks Inc.,	:	**AFFIDAVIT**
Applicant.	:	

----------X

STATE OF NEW YORK)
: SS.:
COUNTY OF NEW YORK)

LACY H. KOONCE, III, being duly sworn, deposes and says:

1. I am associated with the firm of Davis Wright Tremaine LLP, counsel to

Paramount Parks Inc. ("Paramount"), Applicant in the above-captioned opposition. I have personal knowledge of the matters set forth herein.

2. I submit this affidavit in opposition to Opposer Central Mfg. Co.'s motion for reconsideration of the Board's Order of March 9, 2004.

3. In its motion for reconsideration, Opposer cites to language in the Board's Order stating that Applicant, in support of its motion for discovery sanctions, submitted no evidence rebutting the *prima facie* proof of service of Central's discovery responses. Central now cites that language in support of its argument that the Board should not have imposed a requirement that the parties serve and file papers by Express Mail.

4. While Applicant submitted evidence in the form of an affidavit stating that the discovery responses were not timely served, it did not annex documentary evidence. In an effort to clarify this matter in light of Central's new arguments, annexed hereto as Exhibit 1 is a copy of the envelope in which the discovery responses were served on Applicant in September 2002. Although a private postage machine label is affixed to the envelope showing an August 21 postmark, there is no U.S. Post Office cancellation on the envelope and thus no way to determine on which day the envelope was actually mailed.

5. Since the entry of the March 9, 2004 Order, Central has not complied with the Express Mail requirement for all documents served on Applicant; for instance, it served its deposition notices by fax. More importantly, its actions have demonstrated its intent to circumvent even this minimally inconvenient requirement, as set forth below.

6. On April 13, 2004, Central agreed to produce documents responsive to

Paramount's document requests to Paramount by mail, and pledged to send them by Express Mail or other overnight courier to ensure their arrival no later than April 16, 2004. Annexed hereto as Exhibit 2 is a letter of April 13, 2004 to Central confirming this commitment.

7. On April 15, 2004, Central's president Leo Stoller sent a fax stating that he had placed the documents in the mail that day, and attached a copy of the express mail envelope to his fax, purportedly to confirm that the documents had been timely sent. Annexed hereto as Exhibit 3 is a copy of Mr. Stoller's fax.

8. The next day, April 16, 2004, the promised package did not arrive. I attempted to track the package on the United States Postal Service's website by entering the tracking number, but apparently it had not been mailed yet. The package finally arrived the following Monday, April 19, 2004. The tracking detail for that package shows that it was not mailed until 4:11 p.m. on Friday, April 16, 2004, rather than on Thursday, April 15, 2004 as Mr. Stoller represented in his fax. Annexed hereto as Exhibit 4 is a copy of that tracking detail from the United State Postal Service's website.

9. Upon information and belief, this incident and the incident in September 2001 suggest that Mr. Stoller routinely uses a postage machine to put a false postmark on his package, which he then mails at a later date.

LACY H. KOONCE, III

Sworn to before me this
21th day of April, 2004

Notary Public

LORETTA E. PERRY
NOTARY PUBLIC, State of New York
No. 24-4931617
Qualified in Kings County
Commission Expires August 1, 2006

EXHIBIT 1

Kay Collyer & Boose LLP
Lacy H. Koonce, III (LHK-8784)
One Dag Hammarskjold Plaza
New York, New York 10017-2299

P.O. Box 35189
Chicago, IL 60707-0189

EXHIBIT 2

LAWYERS

Davis Wright Tremaine LLP

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April 13, 2004

VIA FACSIMILE AND EXPRESS MAIL

EV418683632US

Mr. Leo Stoller
Hypersonic Brand Products and Services
and Central Manufacturing Co.
P.O. Box 35189
Chicago, IL 60707-0189

Re: Central Mfg. Co. v. Paramount Parks Inc.,
Trademark Trial and Appeal Board Opposition No. 91123765

Dear Mr. Stoller:

We have been informed by Angela Lykos, the interlocutory attorney responsible for the above-referenced TTAB proceeding, that a telephonic conference will be held on Tuesday, April 20, at 10:00 am EST in connection with Opposer's motion to compel the attendance of certain witnesses at depositions currently noticed for April 21, 2004. According to Ms. Lykos, the telephonic conference will not be held today or tomorrow, as she originally suggested, because you have stated that you are unavailable this week. I note that this is somewhat inconsistent with your agreement with me earlier today to make yourself available this afternoon or tomorrow morning for a telephonic conference, and is also somewhat inconsistent with the fact that until we spoke approximately an hour ago and made alternative arrangements, I was scheduled to meet with you in Chicago tomorrow, in connection with Applicant's review of documents responsive to Applicant's discovery requests. However, we have confirmed to Ms. Lykos that we are available next Tuesday as requested.

I have been asked by Ms. Lykos to arrange the conference call on April 20. As you know but apparently neglected to mention to Ms. Lykos, I will be in Chicago to take your deposition on that date, and the deposition is scheduled to commence at 8:00 a.m. local time. I therefore suggest that we take a short break from the deposition at 9:00 a.m. local time to hold the telephonic conference, and resume the deposition afterwards.

Separately, and as noted above, at your request we have agreed that in lieu of my scheduled trip to Chicago to review documents tomorrow, Opposer will produce all documents

responsive to Applicant's document requests no later than this Friday, April 16. To clarify a point in your confirming fax, you stated on the telephone to me that the documents will *arrive* here in New York on April 16 (that is, they will be mailed from Chicago by overnight courier or another method that guarantees arrival by April 16). As you may appreciate, we must receive those documents by Friday in order to prepare for your deposition the following Tuesday. You have also confirmed that Opposer will produce the documents regardless of any Order that the TTAB may issue in the interim suspending activity in this proceeding, by reason of the pendency of any of three the motions you filed last week or otherwise. If you disagree with the foregoing for any reason, it is imperative that you inform me by telephone or facsimile immediately, so that I may reschedule a trip to Chicago tomorrow to review documents.

Very Truly Yours,

Lance Koonce

LK/lp

Mallory D. Levitt, Esq.

FACSIMILE

EXHIBIT 3

DATE: 4-15-04

TO: LANCE FRONEY

FAX: 210 - 489 - 8340

FROM: LEO STOLLEY

FAX: 708-453-0083
VOICE: 773-283-3880
EMAIL: info@rentamark.com

RE Discovery

OF PAGES:
(including this one)

Phase find copy of Express Mail Receipt evidencing that Oppose complied with discovery as agreed.

cordially

Leo Stolley

708 453-0080

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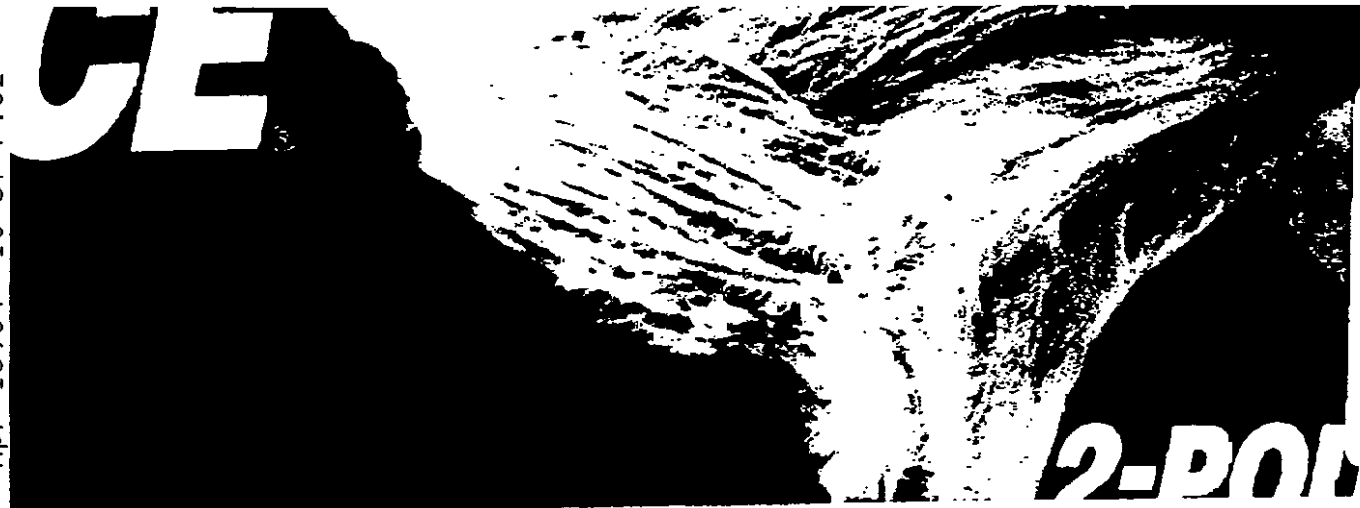

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ORIGIN (POSTAL USE ONLY)			
PO ZIP Code: 60707	Day of Delivery: ☐ Next ☐ Second	Flat Rate Envelope: ☒	
Date In: Mo. 9 Day 15 Year 04	☐ 12 Noon ☐ 3 PM	Postage: $ 18 00	
Time In: ☐ AM ☒ PM	Military: ☐ 2nd Day ☐ 3rd Day	Return Receipt Fee	
Weight: 2 lbs. ozs.	Int'l Alpha Country Code	COD Fee: $	Insurance Fee
No Delivery: ☐ Weekend ☐ Holiday	Acceptance Clerk Initials	Total Postage & Fees: $ 18 00	

DELIVERY POSTAL USE ONLY		
Delivery Attempt: Mo. Day	Time: ☐ AM ☐ PM	Employee Signature
Delivery Attempt: Mo. Day	Time: ☐ AM ☐ PM	Employee Signature
Delivery Date: Mo. Day	Time: ☐ AM ☐ PM	Employee Signature

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PAYMENT BY ACCOUNT
Express Mail Corporate Acct. No.

Federal Agency Acct. No. or Postal Service Acct. No.

NO DELIVERY ☐ Weekend ☐ Holiday

Customer Signature

FROM: (PLEASE PRINT) PHONE ( )

LEO STOLLER
P.O BOX 35189
CHICAGO IL
60707-0189

TO: (PLEASE PRINT) PHONE ( )

LACY KOONCE
DAVIS WRIGHT TREMAINE
1633 BROADWAY
N.Y N.Y
10019 + 6708

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www.usps.com

02/03

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UNITED STATES POSTAL SERVICE

EXHIBIT 4

Home

Track & Confirm

Shipment Details

You entered ER69 5139 370U S

Your item was delivered at 10:53 am on April 19, 2004 in NEW YORK, NY 10019. The item was signed for by W MISBET.

Here is what happened earlier:

- NOTICE LEFT, April 17, 2004, 11:05 am, NEW YORK, NY 10019
- ARRIVAL AT UNIT, April 17, 2004, 9:21 am, NEW YORK, NY 10019
- ENROUTE, April 16, 2004, 4:11 pm, CHICAGO, IL 60607

Track & Confirm

Enter label number:

Go >

Track & Confirm FAQs Go >

Notification Options

- Track & Confirm by email What is this? Go >
- Request Proof of Delivery What is this? Go >

TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Opposition No.:	123,765
Opposer:	Central Mfg. Co.
Applicant:	Paramount Parks Inc.
Mark:	HYPERSONIC
Serial No.:	76/103447 and 76/103448

CERTIFICATE OF MAILING

I hereby certify that the attached Applicant's Memorandum in Opposition to Opposer's Motion To Amend Its Notice of Opposition; Applicant's Memorandum in Opposition to Opposer's Motion for Reconsideration and Affidavit of Lacy H. Koonce, III (on behalf of Applicant, Paramount Parks Inc.) are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service, postage prepaid, under 37 CFR 1.10, in an envelope addressed to: Commissioner for Trademarks, Box TTAB - No Fee, 2900 Crystal Drive, Arlington, Virginia 22202-3514, on the date indicated below.

Express Mail Label No.: EV 418683677 US
Mailing Date: April 27, 2004
Signature: Loretta E. Perry

CERTIFICATE OF SERVICE

I hereby certify that copies of the attached Applicant's Memorandum in Opposition to Opposer's Motion To Amend Its Notice of Opposition; Applicant's Memorandum in Opposition to Opposer's Motion for Reconsideration and Affidavit of Lacy H. Koonce, III (on behalf of Applicant, Paramount Parks Inc.) are being are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service, postage prepaid, under 37 CFR 1.10, in an envelope addressed to Opposer, Leo Stoller, Hypersonic Brand Products & Services & Central Mfg. Co., P.O. Box 35189, Chicago, IL 60707-0189, on the date indicated below.

Express Mail Label No.: EV 418683650 US
Mailing Date: April 27, 2004
Signature: Loretta E. Perry